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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,953	08/02/2001	Molian Deng	38-21(52114)B	9080

27161 7590 03/10/2004

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ST. LOUIS, MO 63167

EXAMINER

MARTINELL, JAMES

ART UNIT PAPER NUMBER

1631

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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6

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Remainder  
sent to wrong  
Address corrected  
Address.

**Office Action Summary**

Application No.

09/920,953

Applicant(s)

DENG ET AL.

Examiner

James Martinell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 April 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 5 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

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Applicant's election with traverse of the requirement for restriction in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the inventions of Groups I and II are related and that search and examination of both would not require a serious burden for the PTO. Applicant further asserts that it would not be a serious burden for the PTO to search and examine as many as ten SEQ ID NOs. This is not found persuasive because the searches for Groups I and II do not overlap and because the patentability issues in connection with polynucleotides differ from those for polypeptides. In connection with the search and examination of more than one SEQ ID NO in this application, it is noted that 1192 O.G. 68 (November 19, 1996) did not create a right to the search and examination of ten unrelated nucleotides but permitted the search and examination of up to ten unrelated nucleotides (one nucleotide is in the range of "up to ten" nucleotides). Since the publication of 1192 O.G. 68 (November 19, 1996), the nucleotide sequence databases have expanded by a factor of about 17. Thus, it would create a serious burden for the PTO to search more than one unrelated nucleotide sequence in an application in view of the computer and human resources required to perform the work. Applicant did not argue that Groups I and II were not independent and distinct and did not argue that the SEQ ID NOs mentioned in the claims are not unrelated nucleotide sequences.

The requirement is still deemed proper and is therefore made FINAL.

Claim 5 is withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no (allowable) generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 5.

The disclosure is objected to because of the following informalities.

- (a) In claim 4, "comprising" should be changed to "comprises".
- (b) At page 36, line 10, two commas appear in tandem. One ought to be deleted.

Appropriate correction is required.

The disclosure is objected to because it contains an embedded hyperlink and/or other forms of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of

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browser-executable code. See MPEP § 608.01. Hyperlinks and/or other forms of browser-executable code appear in at least the following location(s):

- (a) page 66, lines 4-6.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-4 and 6-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are vague, indefinite, and incomplete.

- (a) The recitation of "degenerate variant" (claim 1) is vague and indefinite because the application does not define the term "variant" in this context.
- (b) Claims 1, 4, and 6 are vague and indefinite because they are broader than the elected invention in that they recite more SEQ ID NOs than the one elected.
- (c) The recitation of "fragment thereof" (claim 2) is vague and indefinite because no lower limit is given for the fragment size.
- (d) Claim 3 is incomplete because there is no provision for the claim to refer to a table in the specification.
- (e) Claim 3 is incomplete because it makes an improper incorporation by reference to material that is not in and issued U.S. Patent or allowed U.S. Patent application (see MPEP 608.01(p) I. Table 1 refers to proteins by NCBI gene Descriptions.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 1-4 and 6-10 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. The instant application does not disclose a specific, substantial, and credible utility for SEQ ID NO: 2 or for any polypeptide that is encoded by SEQ ID NO: 2. Table 1 indicates that SEQ ID NO: 2 encodes a polypeptide that is 81% identical to the 60 S ribosomal protein L10 of *Solanum melongena*. However, the instant application does not disclose a patentable utility for either SEQ ID NO: 2 or a polypeptide encoded by SEQ ID NO: 2. In addition, a patentable utility is not readily apparent to one of skill in the art based upon the disclosure in the instant application.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4 and 6-10 rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The discussion in the previous rejection is incorporated here.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

Claims 2 and 3 are rejected under 35 U.S.C. 102(B) as being clearly anticipated by Couture et al (Mol. Gen. Genet. 243 (2), 185 (1994)). Couture et al discloses a DNA that encodes a fragment of the protein encoded by SEQ ID NO: 2. Positions 229-234 of Couture et al encodes the same two amino acids

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as positions 81-86 of SEQ ID NO: 2 (see also the alignment attached to the copy of the reference). Thus, the DNA of Couture et al is embraced by the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Martinell whose telephone number is (703) 308-0296. The fax phone number for Examiner Martinell's desktop workstation is (703) 746-5162. The examiner works a flexible schedule and can be reached by phone and voice mail. Alternatively, a request for a return telephone call may be e-mailed to [james.martinell@uspto.gov](mailto:james.martinell@uspto.gov). Since e-mail communications may not be secure, it is suggested that information in such requests be limited to name, phone number, and the best time to return the call.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Woodward, can be reached on (703) 305-4028. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
**James Martinell, Ph.D.**  
**Primary Examiner**  
**Art Unit 1631**